

REMARKS

Reconsideration of this application and the rejection of claims 33, 34, 36, 37, 39-41 and 43 are respectfully requested. Applicants have attempted to address every objection and ground for rejection in the Office Action dated November 15, 2006 (Paper No. 20061112), which has been made Final, and believe the application is now in condition for allowance, or in the alternative, in better form for an Appeal. The claims have been amended to more clearly describe the present invention.

Claims 33, 34, 36, 37 and 39-41 stand rejected under 35 U.S.C. §103(a) as being unpatentable over French (U.S. Pat. No. 5,020,256). French discloses a handrail 1 for an escalator having a groove or recess 3 in an upper portion thereof. An advertisement 14 is placed within the groove 3 and is illuminated from underneath by a photo-luminescent light source. A cover 6 is placed over the advertisement to protect it from damage and dirt.

Applicants submit that French neither discloses nor suggests all of the features recited in amended claim 33 and previously presented claim 39. Specifically, amended claim 33 recites, among other things, "...an exposed and uncovered photo-luminescent material located and being filled to below a top of any given said one of a channel or a depression, said photo-luminescent material being a dry powder formulation fused directly to said one of a channel or a depression..." Previously presented claim 39 similarly recites, among other things, "...depositing the dry powder formulation onto the substrate to thereby fill the one

of a depression or a channel... and heating the dry powder formulation to fuse it to the substrate to thereby create a fused material....”

In contrast, in French, use of a luminescent printing is disclosed, where the luminescent printing is printed directly onto a card, or is heat stamped to the card or an existing handrail. (Col. 4, ll. 13-17 and 27-30). French neither discloses nor suggests the luminescent printing as a dry powder formulation “filling” the depression/channel. Further, French fails to disclose or suggest the luminescent printing as being fused to the channel/depression. Also, French fails to disclose or suggest an exposed and uncovered photo-luminescent material, as recited in amended claim 33 and previously presented claim 39.

Applicants also respectfully disagree with the Examiner’s contention that it would have been obvious to remove the covering and its intended function, and respectfully submit that modifying French as suggested would render the reference unsatisfactory for its intended purpose. Specifically, in French, each of the discussed embodiments explicitly discloses use of a cover or hardenable liquid coating to protect the printed advertising material from dirt/damage. Because the printed material is located on an escalator handrail, Applicants submit that the material must be covered to prevent dirt and harmful germs from penetrating the printed material. Applicants further submit that when riding an escalator, the majority of users place their hands on the handrail for stability on the moving device. The cover or liquid coating disclosed in French prevents germs/dirt from

users' hands from contaminating the printed material, and also prevents damage to the printed material.

French neither discloses nor suggests removing the covering from the printed material and exposing it to dirt/damage. Thus, removing the covering would be contrary to the explicit teachings of the reference. Applicants note the Examiner's reliance on *In re Karlson* (136 USPQ 184, CCPA 1963), but submit that this is not a mechanical rule, and that the language in *Karlson* was not intended to short circuit the determination of obviousness mandated by 35 U.S.C. §103. *Ex Parte Gerd Ohrnberger and Helmut Dillig*, 1996 WL 1749366 (Bd. Pat. App. & Interf. 1996), citing *In re Wright*, 343 F.2d 761, 769-770, 145 USPQ182, 190 (CCPA 1965). Indeed, Applicants note that one pertinent indicator of nonobviousness is 'teaching against' the claimed invention by the prior art, and that "there must be a reason or suggestion in the art for selecting the procedure used, other than the knowledge learned from the applicant's disclosure." *In re Dow Chemical Co.*, 837 F.2d 469, 473 (CAFC 1988). Applicants submit that there is no suggestion in French to remove the cover or protective coating from the handrail and that the Examiner's contention is impermissible hindsight construction of the Applicants' disclosure. Accordingly, Applicants respectfully traverse the rejection of claims 33, 34, 36, 37 and 39-41 under 35 U.S.C. §103(a).

Claims 33, 34, 36, 37 and 39-41 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Glatz et al. in view of Tassey et al. (U.S. Pat. No. 6,237,266). Glatz discloses a photo-luminescent safety accessory or tread

cover 100 including a photo-luminescent strip 114 adhered thereto. The strip 114 is arranged level with the tread cover 100. The Examiner acknowledges Glatz's failure to disclose recessing the photo-luminescent material. Tassey discloses a baseboard-mounted evacuation aid having photo-luminescent indicators 20 that are preferably located on a strip of vertically arranged carpet 12 to have a surface 22 that is either recessed below or raised above a surface 24 defined by carpet fibers 16. (Col. 4, ll. 34-44).

Applicants submit that neither Glatz nor Tassey, either alone or in combination, discloses or suggests all of the features recited in amended claim 33 and previously presented claim 39. Specifically, Applicants submit that the photo-luminescent material in Glatz is a resin and not a dry powder formulation, as recited in claims 33 and 39. Applicants further submit that it is well known in the art that a resin is "any of a class of solid or semisolid viscous substances obtained either as exudations from certain plants or prepared by polymerization of simple molecules" (see dictionary.reference.com). Accordingly, a "resin" cannot be classified as a "dry powder formulation," as recited in claims 33 and 39.

Further, Applicants submit that Glatz fails to disclose or suggest modifying the wall base 400 so the photo-luminescent material 410 extends to below a top surface of the wall base exterior surface 402. (Col. 6, ll. 9-24; FIG. 4). Specifically, Applicants submit that Glatz teaches against locating the photo-luminescent material below the top surface of the channel. Specifically, Glatz discloses the wall base 400 having a "smooth continuous exterior surface 402,"

where the photo-luminescent strip 410 is “continuously formed along exterior surface 402” (Col. 6, ll. 12-19). Applicants submit that if the strip 410 were to be recessed below the channel, the exterior surface 402 would not have a “smooth continuous surface,” as desired. Accordingly, Applicants submit that there is no incentive or motivation to modify Glatz by combining it with Tassey as suggested by the Examiner, and respectfully traverses the rejection of claims 33, 34, 36, 37 and 39-41 under 35 U.S.C. §103(a).

Claim 43 stands rejected under 35 U.S.C. §103(a) as being unpatentable over either French or Glatz in view of Tassey as applied to claims 33, 34, 36, 37 and 39-41, and further in view of the Applicants’ discussion of the prior art. The arguments made above traversing French, Glatz and Tassey are reasserted here.

Applicants submit that there is no motive or incentive to modify either French or Glatz as suggested by the Examiner. Specifically, neither reference discloses or suggests manufacturing the substrate from a metal. Applicants further submit that in view of the arguments made above with respect to claim 39, from which claim 43 depends, claim 39 is currently in allowable form. Accordingly, Applicants submit that claim 43 is also in allowable form, and respectfully traverse the rejection of claim 43 under 35 U.S.C. §103(a).

New claims 44 and 45 have been added to the application, and Applicants submit that they are in allowable form. Specifically, new claim 44 incorporates features from claims 39-41 and 43. Applicants submit that none of

French, Tassey or Glatz, either alone or in combination, discloses or suggests all of the features recited in new claim 44. Specifically, as stated above with respect to French, modifying French to remove the protective cover over the printed material would explicitly be against the teachings of French. Further, Applicants submit that as argued above with respect to Tassey and Glatz, neither reference suggests or discloses filling the photo-luminescent material to below a top surface of the substrate channel or depression, where the substrate is metallic and the photo-luminescent material is a dry powder formulation.

Applicants further submit that in view of the arguments made above with respect to claim 44, claim 45, which depends from claim 44, is also in allowable form. Specifically, because the substrate recited in claim 44 is one of a handrail or step nosing, Applicants submit that it is necessary to provide traction on the surface of the substrate to prevent slippage of the user's hand or foot. Applicants contend that none of the cited references, either alone or in combination, suggest or disclose filling the substrate channels or depression to below a top surface of the channel or depression, to preserve traction, as recited in new claim 45.


In view of the above amendments, the application is respectfully submitted to be in allowable form, or alternatively, in better form for an Appeal. Allowance of the rejected claims is respectfully requested. Should the Examiner discover there are remaining issues which may be resolved by a telephone

Serial No.: 10/734,221
Filed: December 12, 2003

interview, he is invited to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,

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